REMARKS/ARGUMENTS

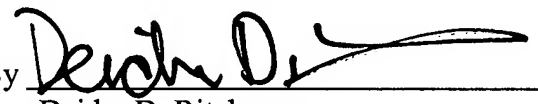
The foregoing remarks are made in response to the Office action issuing the Notice of Non-Compliant Amendment dated May 4, 2007 in response to the response filed by Applicant on August 21, 2006. No claims are amended, added or cancelled. Claims 1-9 remain pending.

On page 2 of the Office action, the Examiner indicated that the response filed by Applicant on August 21, 2006 ("the response") is considered non-compliant because the amendment is unsigned or is not signed in accordance with 37 C.F.R. 1.4. Applicant notes that the response was signed by Attorney Rose Hickman, USPTO Registration No. 54,167, but that the signature appears somewhat muted in the copy printed by the USPTO and stored on the USPTO online system. Applicant submits herewith a duplicate of the Remarks/Arguments section of the response. The instant response is signed by Applicant's Attorney, Deidra Ritcherson, USPTO Registration No. 55,574, in compliance with 37 C.F.R. 1.4

If there are any remaining issues, the Examiner is cordially invited to call the Applicant's Attorney at the number listed below.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 

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DDR/sls

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ATTACHMENT

REMARKS/ARGUMENTS

The foregoing remarks are made in response to the Office action of April 19, 2006. No claims are amended, added or cancelled. Claims 1-9 remain pending.

On pages 2-4 of the Office action, claims 1-9 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Sloane et al. (U.S. 5,813,863) ("Sloane"). The Applicant respectfully traverses these rejections.

Applicant respectfully submits that Sloane does not anticipate any pending claims of the present application because it does not disclose all of the claimed limitations of independent claim 1 nor all of the claimed limitations of any of claims 2-9, which depend from independent claim 1.

Claim 1 recites, in part: "[a] method of educating a child using a media presentation device in communication with a user interface, comprising: identifying a problem behavior exhibited by the child; . . . selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior. . . ."

Regarding the claim 1 limitation of "identifying a problem behavior exhibited by the child," on page 2 of the Office action, the Examiner states that "Sloane's invention is capable of identifying a problem behavior (e.g., drug use) exhibited by the child." (Emphasis added). In the Examiner interview conducted on July 25, 2006, the Examiner elaborated that these limitations are inherent in Sloane because a person using

Sloane's system may use it to identify a problem behavior in someone else in order to recommend the system to that person.

The Applicant respectfully submits that the Examiner inappropriately relies on the mere probability or possibility that Sloane's system is capable of disclosing the claimed limitations. Accordingly, the Applicant respectfully submits that the Examiner has not made a prima facie case that all of the claimed limitations of claim 1 are anticipated by Sloane.

To anticipate a claim, each and every element of the claim must be found either expressly or inherently in a single prior art reference. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present n the thing described in the reference . . . .'" *Id.* at 745 (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). "'Inherency, however, may not be established by probabilities or possibilities.'" *Id.* (quoting *Continental Can Co.* at 1269).

In *In re Robertson*, the Federal Circuit found that the USPTO Board erred when it found anticipation by inherency in a diaper fastening and disposal system on the basis that the elements of the system could operate in a certain way or merely was capable of being intermingled to perform a function. The Court found that the USPTO Board erred because the Board's analysis did not rest on an element that was necessarily disclosed but was merely a probability or possibility of the invention.

Section 2112(IV) of the MPEP also supports this point. Section 2112(IV) states that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not

sufficient to establish the inherency of that result or characteristic. (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). Section 2112(IV) further quotes the language elaborated upon above citing *In re Robertson*.

Accordingly, the Applicant respectfully asserts that the Examiner's reasoning that "Sloane's invention is capable of identifying a problem behavior" does not appear to be sufficient evidence to establish anticipation by inherency. Therefore, no sufficient evidence is provided that Sloane anticipates the claimed limitation of "identifying a problem behavior exhibited by the child."

Moreover, the Examiner's contention that someone may use Sloan's system to identify those with the actual problem behavior addressed in the game is not supported by any disclosure in Sloane or elsewhere. Therefore, for this reason alone, the Applicant requests that the Examiner withdraw the rejection of claim 1 and allow claim 1 and, dependent claims 2-9.

Additionally, Sloane teaches a system wherein the user enters a input indicative of decisions that the user makes for a character in a video game regarding accepting alcohol and/or drugs. These are not actual actions taken by or actual behaviors exhibited by the user (abstract; col. 8, lines 25-33). The Applicant can find no disclosure in Sloane of the claimed limitation of "identifying a problem behavior exhibited by the child" nor "selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior." (Emphasis added).

Applicant can find no disclosure in Sloane of the claimed limitation of "identifying a problem behavior exhibited by the child; . . . selecting through the user interface an educational time-out presentation to present to the child that corresponds to the problem behavior." (Emphasis added). Accordingly, the Applicant requests that the Examiner withdraw the rejection of claim 1 and allow claim 1.

Claims 2-9 depend from independent claim 1. As such, these dependent claims necessarily incorporate the limitations of their respective independent claim and are therefore patentable at least for the reasons presented above for claim 1. The Applicants therefore request that the Examiner withdraw the rejections of claims 2-9 for at least these reasons and that these claims be allowed.

The Applicant asserts that claims 2 and 5-9 are also patentable for their additional limitations.

Dependent claim 2 recites, in part: "[t]he method of claim 1, wherein identifying the problem behavior further includes: monitoring the child's behavior; and intervening in the child's behavior whereby the child associates the intervention with the problem behavior."

On pages 2 and 3 of the Office action, the Examiner cites col. 8, lines 30-33 of Sloane as disclosing these limitations. Col. 8, lines 30-33 of Sloane, however, disclose that as the character in the video game, not the actual user playing the video game, is cajoled into accepting alcohol or drugs, the number of drinks and/or drugs that the character accepts is

tracked. Accordingly, the cited portion of Sloane does not disclose at least the limitations monitoring the child's behavior; and intervening in the child's behavior whereby the child associates the intervention with the problem behavior." (Emphasis added). Additionally, the Applicant can find no disclosure in Sloane of the claimed limitation.

Therefore, for at least this reason also, the Applicant requests that the Examiner withdraw the rejection of claim 2 and allow claim 2.

Dependent claim 4 recites, in part: "[t]he method of claim 1, wherein the educational time-out presentation includes: a calming segment; and an educational segment."

The Examiner has not printed out and Applicant can not find any disclosures in Sloane of a calming segment, and requests that the Examiner withdraw the rejection of claim 4 and allow claim 4.

Claim 5 recites, in part: "[t]he method of claim 4, wherein the educational segment includes a multimedia comparison between correct and incorrect choices, the multimedia comparison including visual, auditory, and musical depictions of the choices."

Regarding the claim limitations of claim 5, on page 3 of the Office action, the Examiner states that "Sloane's invention is capable of providing wherein the educational segment includes a multimedia comparison between correct and incorrect choices, the multimedia comparison including visual, auditory, and musical depictions of choices due to its incorporation of multimedia software." (Emphasis added).

As discussed above, the mere probability or possibility that Sloane's system is capable of the claim limitations of claim 5 is insufficient to make out a prima facie case of anticipation.

Additionally, while Sloane may teach that the video game informs the character of whether the character's answers to questions of a quiz are right or wrong (col. 10, lines 16-20) and while the video game may be developed with cast members that take the form of multimedia clips that may be text pages, digital sound files, digital video files, etc. (col. 4, line 58 - col. 5, line 2), the cited portions of Sloane do not disclose the claim 5 limitation of "[t]he method of claim 4, wherein the educational segment includes a multimedia comparison between correct and incorrect choices, the multimedia comparison including visual, auditory, and musical depictions of the choices." (Emphasis added).

Therefore, for at least this reason also, the Applicant requests that the Examiner withdraw the rejection of claim 5 and allow claim 5.

Claim 6 recites, in part: "[t]he method of claim 4, wherein the educational segment includes: a scene acknowledging the child's feelings; a scene identifying the child's incorrect choices; a scene depicting a child in the presentation making an incorrect choice; a scene querying the child about the child's choices, the scene contrasting a correct choice from an incorrect choice; a scene where the child in the presentation makes a correct choice; and a scene praising the child for being a person who wants to make a correct choice."

Regarding the claim limitations of claim 6, on pages 3 and 4 of the Office action, the Examiner states that Sloane discloses the various limitations of claim 6 and cites to figs. 3, 4 and 8 for support.

The cited figures of Sloane address only a character in a video game. There is no disclosure of an additional party being addressed or evaluated nor of the scenes recited in the claim.

Further, Sloane discloses that the video game provides a synopsis of the context in which a character in the video game, not the actual user playing the video game, will later make decisions in the video game (fig. 3), decisions made by the character, not the actual user playing the video game (fig. 4) and a contrast of the decisions made by the character, not the actual user playing the video game (fig. 8).

Accordingly, the cited portions of Sloane do not disclose the claim 6 limitations of: "[t]he method of claim 4, wherein the educational segment includes: a scene acknowledging the child's feelings; a scene identifying the child's incorrect choices; a scene depicting a child in the presentation making an incorrect choice; a scene querying the child about the child's choices, the scene contrasting a correct choice from an incorrect choice; a scene where the child in the presentation makes a correct choice; and a scene praising the child for being a person who wants to make a correct choice." The Applicant can find no disclosure in Sloane of the claimed limitations.

Therefore, for at least these reasons also, the Applicant requests that the Examiner withdraw the rejection of claim 6 and allow claim 6.

Claim 7 recites, in part: "[t]he method of claim 6, wherein the scene acknowledging the child's feelings includes a song segment."

Regarding the claim limitations of claim 7, on page 4 of the Office action, the Examiner states that "Sloane's invention is capable of providing . . . a scene acknowledging the child's feelings [, which] includes a song segment due to its incorporation of multimedia software." (Emphasis added).

Again, the mere probability or possibility that Sloane's system is capable the limitations of claim 7 is insufficient.

While Sloane may teach the video game may be developed with cast members that take the form of multimedia clips that may be text pages, digital sound files, digital video files, etc. (col. 4, line 58 - col. 5, line 2), the cited portions of Sloane do not disclose a scene acknowledging the child's feelings or such a scene that includes a song segment.

Therefore, for at least these reasons also, the Applicant requests that the Examiner withdraw the rejection of claim 7 and allow claim 7.

Claim 8 recites, in part: "[t]he method of claim 6, wherein the scene querying the child about the child's choices includes a song segment."

Regarding the claim limitations of claim 8, on page 4 of the Office action, the Examiner states that "Sloane's invention is capable of providing . . . a scene querying the child about the child's choices [, which] includes a song segment due to its incorporation of multimedia software." (Emphasis added).

As discussed above, the mere probability or possibility that Sloane's system is capable of the claimed limitations is

insufficient to make out a prima facie case that the claim limitations of claim 8 are anticipated by Sloane.

Additionally, while Sloane may teach the video game may be developed with cast members that take the form of multimedia clips that may be text pages, digital sound files, digital video files, etc. (col. 4, line 58 - col. 5, line 2), Applicant can find no disclosure in Sloane of either a scene querying the child (user) about the child's choices nor of such a scene including a song segment. Accordingly, Applicant requests that claim 8 be allowed.

Claim 9 recites, in part: "[t]he method of claim 1, wherein presenting the educational time-out presentation further includes isolating the child from any distractions during the presentation of the educational time-out presentation."

On page 4 of the Office action, the Examiner merely states: "[r]egarding Claim 9, presenting the educational time-out presentation in Sloane is considered to include isolating the child from any distractions during the presentation of the educational time-out presentation" without pointing to any disclosure in Sloane that expressly or inherently discloses the claim 9 limitation. As such, the Examiner has not established a prima facie case that the claim limitations of claim 9 are anticipated by Sloane.

Therefore, for at least this reason also, the Applicant requests that the Examiner withdraw the rejection of claim 9 and allow claim 9.

In view of the above remarks it is submitted that the claims are patentably distinct over the cited references and

that all the rejections to the claims have been overcome. Reconsideration and reexamination of the above Application is requested.

If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to call the Applicants' Attorney at the number listed below.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

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